

**REMARKS**

Applicants appreciate the withdrawal of various 35 U.S.C. §102 rejections as set forth in paragraphs 2-5 of the Office Action.

Applicants have amended claims 6, 9 and 12 to correct typographical errors and claims 10, 14 and 15 have been written in independent form.

Although it was inherent in previous claim 1 that the different aesthetic or mechanical properties were achieved by selecting different decorative surfaces from the Markush group, claim 1 has been amended to further emphasize that the differing aesthetic or mechanical properties flow from the use of different upper decorative surfaces selected from the previously recited Markush group. No new matter nor new issues arise from the amendment.

Reconsideration of the previous rejection of claims 1, 4-6, 8-9 and 13 under 35 U.S.C. §102(b) as being anticipated by Hansson et al (U.S. Patent No. 6,465,046) is respectfully requested.

Initially, Applicants remind the Examiner that an anticipation rejection under 35 U.S.C. §102(b) requires an identity of each and every element of the claim with a single prior art reference. The Office has stressed this in MPEP §2131 by stating “to anticipate a claim, the reference must teach every element of the claim” and further “a claim as anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (citation omitted)”.

This the Examiner has not done.

While Hansson ‘046 may teach a system of panels where the decorative surface pattern, such as a map, extends over several panels, such does not meet the further limitations of at least two of the decorative surfaces of the flooring system are selected from the group consisting of thermosetting composite, thermoplastic composite elastomeric foil, thermoplastic foil, metal sheet, fabric, mineral and a mineral composite. Although the Examiner has taken the approach

that when a plurality of panels are present and they each have the same composition, e.g., a thermosetting composite, such as in independent claim 1, they differ if the pattern differs.

Applicants respectfully disagree.

Applicant's invention is a flooring system wherein the various panels "differ" from another panel. This difference is affected not by the pattern, but by the decorative surface being selected from the Markush group provided. Previous claims 10, 14, 15 and 16 are specific combinations of different panels such as a thermosetting composition and another of elastomeric foil or one of the elastomeric foil and a high gloss wood design of thermosetting composite. It cannot be said that the Examiner did not reasonably understand Applicant's process but in order to further emphasize the difference, Applicants have amended independent claim 1 to make it clear that at least two of the decorative surfaces of the flooring system being different and being selected from the Markush group of materials.

Previous claims 14, 15 and 16 did not need such a limitation and, accordingly, the limitations of previous claim 1 have been incorporated into claims 14 and 15, as well as claim 10 (from which claim 16 depends), which have been rewritten into independent form as will be discussed further herein below.

Accordingly, withdrawal of the rejection is respectfully requested.

Claims 1 and 13 also stand rejected, alternatively, under 35 U.S.C. §102(e) as anticipated by Sjoberg (U.S. Publication No. 2004/0170812) or under 35 U.S.C. §103(a) as obvious over Sjoberg. The rejection here is even more tenuous than that made above. The Examiner states that the panel has different aesthetic appearances due to the surface structures 1, 2 and 3, wherein some of the panels have five surface structures on a side while other panels have four panels on a side. However, the Examiner is mistaken as to what constitutes a panel. As shown in Fig. 1 of Sjoberg is a panel having different patterning on the panel. However, such panels are identical with others of the system, as can be understood by reading pg. 2, paragraph [0024] where it is

stated “at least two surface structures having different visual characteristics is used, where two adjacent outermost surface structure areas 10<sup>L</sup> and 10<sup>R</sup> respectively within the same board 1 as different surface structures”. As described in paragraph [0032] on page 3, in connection with Fig. 9, the patentee states “Fig. 9 shows schematically the embossing of an installed floor consisting of rectangular decorative boards 1 according to the invention. The boards 1 used corresponds mainly with the embodiment shown in Fig. 3”. Thus, although the surface patterns in Fig. 3 differ within the same board from each other, Fig. 3 shows a single board having a multiplicity of patterns and not a multiplicity of boards having different patterns. Thus, the Examiner is mistaken that Sjoberg provides any teaching of anticipatory subject matter of claims 1 and 13. Withdrawal of the rejection is therefor respectfully requested.

The combination of Sjoberg '812 with Martensson (U.S. Patent No. 6,397,547) does not cure the deficiencies of the Sjoberg reference when used to reject claims 1-3, 7 and 11 under 35 U.S.C. §103(a). As noted above, Sjoberg teaches a single panel (Fig. 3) which when assembled with a plurality of identical panels as in Fig. 9, produce a floor system. However, each of the panels is identical to one another and, thus, could not possibly meet the basic limitations of the claims. While Martensson does provide a flooring system with edges and edges being provided with means for joining, Martensson admittedly “fails to explicitly disclose at least one panel differing in at least one of an aesthetical or mechanical properties from another panel of the system”. Thus, the rejection does not establish a *prima facie* case of evidence for the claimed invention.

Further, reconsideration of claims 1, 10 and 14-16 as rejected under 35 U.S.C. §103(a) as being unpatentable over Sjoberg (WO 02/47906) in view of the Sjoberg '812 publication is respectfully requested. The deficiencies of Sjoberg '812 has been noted above. However, in this case it is clear that claims 14 and 15 specify that the two panels have upward decorative surfaces of different materials, specifically, one of thermosetting composition and another of a elastomeric foil (claim 14) or, alternatively, elastomeric foil and a high-gloss wood design of

thermosetting composite (claim 15). While the Sjoberg WO publication is taken with the Sjoberg publication, the admission that the Sjoberg WO publication “fails to expressly disclose at least one panel differing and at least one of the aesthetic and mechanical properties from another panel of the system” even when combined with the Sjoberg ‘812 publication, does not satisfy the limitations of claims 14 and 15. Although the Examiner seems to believe that the Sjoberg WO publication teaches an elastomeric foil comprising thermoplastic elastomers citing page 2, lines 15-22, it is clearly stated on page 1 of the WO publication that “the invention relates to a process for the manufacture of a decorative laminate, which laminate comprises an upward decorative and abrasion resistant thermosetting laminate layer and a carrying core. The invention is characterized that the upper side of the core is provided with the abrasion resistant thermosetting laminate with a dampening foil of an elastomer arranged between the upper side of the core and the abrasion resistant thermosetting laminate. Thus, there is no support whatsoever to meet the limitations of claims 1, 10 and 14-16 because the claims require the “decorative surface” of the flooring system be comprised of elastomeric foil, not that all elastomeric foil is sandwiched between such decorative surface and a carrying core as in Sjoberg WO publication.

Additionally, Applicant notes that the Examiner attempts to negate the express limitations of Applicant's claim 15 by stating that it is “intended use”, and is not further limitating insofar as the structure is concerned. Wherever Applicants point out that the claim specifically recites that the elastomeric foil is one surface placed on the panels while the rest of the floor has a high-gloss wood design of thermosetting composite. Thus, notwithstanding the Examiner's characterization of “intended use” the structure of the floor clearly is different from those of the cited references and nothing therein can establish a *prima facie* case of obviousness for claim 15. Accordingly, withdrawal of the rejection is respectfully requested.

Reconsideration and withdrawal of the rejection of claims 1 and 12 under 35 U.S.C. §103(a) as being unpatentable over Pervan (U.S. Publication No. 2002/0007609) in view of Sjoberg ‘812 publication is respectfully requested. The Examiner's explanation of the Pervan

'609 publication is not at all consistent with the teachings with the Pervan publication. Although the Examiner alleges that each panel of Pervan '609 is provided with an upward decorative surface of metal sheet, citing paragraphs 9, 62 and Fig. 6, such is not at all described by Pervan. As described in paragraph 9, a flat strip 6 which can be a resilient aluminum sheet, is fixed at the bottom not upper decorative surface. It is clear that the top side of the panel 2, as described in paragraph 8, is not formed of metal. Thus, there is no description whatsoever to support the Examiner's statements of Pervan's teachings as set forth in the preceding Office Action. This is clear because the Examiner concedes that Pervan fails to disclose that at least one panel differs in at least one aesthetical mechanical properties from another panel of the system. The deficiencies of Sjoberg '812 as in Fig. 3 have been noted above and the Examiner's misinterpretation of different patterns on a single panel, as in Fig. 3, have been noted where Fig. 9 makes it clear that the floor is made up of a system of identical panels. Thus, each panel does not differ aesthetically or mechanically from another panel of the system.

Reconsideration of the previous rejection of claims 17-18 under 35 U.S.C. §103(a) as being unpatentable over Sjoberg '812 publication in view of Bettinger (U.S. Patent No. 3,811,237) is respectfully requested. The deficiencies of Sjoberg '812 have been discussed above. Bettinger does not cure the deficiencies of Sjoberg '812. Although Bettinger discloses a system of rectangular floor panels or tile supported in spaced relation above a suitable subfloor by metal lattice, such a floor is not at all combinable with that of Sjoberg '812. Firstly, there is no manner in which the adjacent floor panels are secured one to the other because in Bettinger there can be no edges provided with means for joining and if one skilled in the art were to attempt to combine the Bettinger core, covered by a flexible or resilient material, such as pile floor carpeting, over the edge of the panel as indicated at 58 and described at column 4, lines 34-45, there is no way that such combination can produce the claimed invention. First, there is not even a system of joinable boards but merely juxtaposed panels supported on a lattice. The panels so made would have no way to be joined into a system and there is no disclosure of joinable panels having different decorative surfaces. Withdrawal of the rejection is respectfully

requested.

Reconsideration of the previous rejection of claims 19 and/or 20 over the Sjoberg '812 publication in view of Bettinger discussed above and Martensson (U.S. Patent No. 6,397,547), or alternatively, Sjoberg '812 in view of Bettinger and the Sjoberg publication is respectfully requested.

The deficiencies of each of the primary combinations have been discussed above. However, the Examiner still does not have the basic combination of a flooring system having two different floor surfaces and even if one were to select the thermoplastic foil (as in claim 19) or the elastomeric foil (as in claim 20) there is nothing in the proposed combination references that would have provided a flooring system comprising a plurality of panels wherein the panels would have different surfaces such as the thermoplastic foil in combination with thermosetting composite or, alternatively, elastomeric foil in combination with thermoplastic composite. For all the foregoing reasons, withdrawal of all rejections and pass of the application to issue are respectfully requested.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith, or credit any overpayment, to our Deposit Account No. 14-1437, under Order No. 8688.049.US0000.

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